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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,835	08/30/2001	Vladimir Jovancevic	194-26872-US	3322
24923	7590	10/24/2005	EXAMINER	
PAUL S MADAN MADAN, MOSSMAN & SRIRAM, PC 2603 AUGUSTA, SUITE 700 HOUSTON, TX 77057-1130			METZMAIER, DANIEL S	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 10/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/944,835

Applicant(s)

JOVANCICEVIC ET AL.

Examiner

Daniel S. Metzmaier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6,7,10-13,16,17 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,7,10-13,16,17 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. 10/19/2005.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-3, 6-7, 10-13, 16-17 and 20 are pending.

This is responsive to applicants' telephone inquiry of Oct. 19, 2005. See attached. The Office Action of Oct. 3, 2005 is hereby vacated and the following issues remain.

Terminal Disclaimer

1. The terminal disclaimer filed on July 14, 2005 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of 6,774,094 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(f) he did not himself invent the subject matter sought to be patented.

3. Claims 1-3, 6-7, 10-13, 16-17 and 20 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. Claims 1-3, 6-7, 10-13, 16-17 and 20 are directed to an invention not patentably distinct from claims 1-2, 4-5, 6, 8-10, 12-14, and 16 of currently commonly assigned to Baker Hughes Incorporated, Jovancicevic et al, US 6,774,094. Specifically, the claims are generic to the use of polycarboxylic acids (see column 2, lines 65 et seq) and salts thereof (see column 3,

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lines 21 et seq, particularly line 66). Thus, Jovancevic et al '094 anticipates the instant invention under 35 USC 102(f).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-3, 6, 7, 10-13, 16, 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knox et al, 4,927,669, in view of Fischer et al, US 5,292,480. Knox et al (abstract; column 2, lines 30 et seq; examples and claims) discloses adding maleated fatty acids neutralized with imidazoline (amine) to a fluid in an amount (examples, Table I) of 750 and 6000 ppm of said fluid. The drag reducing function and an amount of the additive effective to reduce drag would have been inherent to the methods and compositions of Knox et al since the methods and compositions read on

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and are otherwise anticipate by the additive and addition thereof, i.e., method steps and concentrations read on their use as a corrosion inhibitor. The instant claims do and the instant disclosure does not preclude the inherent function of the instant claims from the ability to perform a corrosion inhibiting function as well as a drag reducing function.

The relationship of the drag reduction as a function of concentration would have been expected to have at least a minimum threshold to function, which would be above 100 ppm as the lower limit claimed. The relationship would be expected result in decreasing drag with increasing agent concentration to a maximum threshold. The claims merely require a reduction in drag and an effective amount to achieve said reduction. Since the reference adds the same agent at the upper end of applicants' concentration range, it is reasonable to conclude that said concentration is inherently an effective amount to reduce drag.

To the extent the 750 ppm does not include the amount of imidazoline base, a stoichiometric amount of imidazoline base (MW ~ 70) would result for a maleated fatty acid (MW ~ 400) in a concentration of less than 1000 ppm claimed ($750 \text{ gm/kg} / 400 \text{ gm/mol MW Acid} \times 470 \text{ gm/mol Acid} + \text{Base} \sim 880 \text{ ppm}$).

Knox et al differs from the claims in the requirement that the addition be continuous.

Fischer et al discloses related acid anhydride esters as corrosion inhibitors for oil field down hole use. Fischer et al (column 8, lines 52-59; column 12, lines 7-12, 31-35, and 52-56) shows that the continuous addition of corrosion inhibitors in down hole

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applications employing the Knox et al class of corrosion inhibitors is known in the corrosion inhibiting art to those having ordinary skill in the art.

These references are combinable since they teach maleanized fatty acids as corrosion inhibitors in oil field down hole applications. It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to add the corrosion inhibitors taught in the Knox et al reference continuously to maintain the corrosion protection in the oil field application shown to be conventional for said utility in the Fischer et al reference.

Response to Arguments

7. Applicant's arguments filed July 14, 2005 have been fully considered but they are not persuasive.
8. Applicant's arguments with respect to claims 1-3, 6, 7, 10-13, 16, 17 and 20 over Knox et al have been considered but are moot in view of the new ground(s) of rejection.
9. The assignment recitation is not sufficient to obviate the 35 USC 102(f) rejection above. See MPEP 2137.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (571) 272-1089. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Daniel S. Metzmaier
Primary Examiner
Art Unit 1712

DSM